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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 14

Application Number: 09/990,054
Filing Date: November 21, 2001
Appellant(s): Dean R. Dodge, et al.

Michael J. Schmidt

For Appellant

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APPELLANT'S REPLY BRIEF

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This Reply Brief is in response to the Examiner's Answer which was mailed on November 21, 2003.

REJECTIONS UNDER 35 U.S.C. § 112

The Examiner has included the rejection of Claim 6 under 35 U.S.C. § 112 which Applicants believed had been overcome by the Amendment filed June 24, 2003. In the July 21, 2003 Advisory Action, the Examiner stated that the "112 first rejection of Claim 6" was overcome. Regardless, Applicant respectfully traverses this rejection. The Examiner has objected to the term **only** first and second valve discs and the bolt 66 provides support for the discs and thus **could be considered** part of the valve.

The argument against this interpretation is that if the claim states that the valve comprises **only** first and second valves then the bolt 66 cannot be considered part of the valve, it is a mounting structure for the valve. The Examiner then argues that use of the word **only** does not limit the claim language in light of the open ended term "comprising". The argument against this interpretation is that if the valve is considered as having additional elements other than the two valve discs, the valve can have **only** two valve discs, not one, not three, only two. Under either interpretation, it is clear that the valve has **only** two valve discs. Whether the valve body and the nut are considered part of the valve or not is immaterial as Applicants believe that it is clearly defined that the valve has only first and second valve discs.

The Examiner has indicated that Claims 1-3 are rejected under 35 U.S.C. § 112 second paragraph because Claim 1 recites the limitation "said single outer chordal edge" and there is insufficient antecedent basis for this limitation. This rejection was in the Final Office Action and was caused by a typographical error. On page 3 of the June 24, 2003 Amendment, which was entered by the Examiner, the typographical error was corrected. In the listing of the claims in Applicants' Appeal Brief, which the Examiner agreed was a correct copy, the third line from the bottom reads "truncated by a single outer chordal edge, said single outer chordal edge". Thus, there is sufficient antecedent basis for this limitation.

REJECTIONS UNDER 35 U.S.C. § 103

In the Examiner's Reply, the Examiner has simply copied the rejections which were presented in the Final Office Action. Thus, Applicants' Appeal Brief details Applicants' position with regard to these rejections.

The Applicants have one additional comment regarding the Examiner's position that Yamaura, et al. discloses that the second valve disc has an outer edge in the area of element 158 supporting the valve disc at a position between the outside edge and a central axis of the first valve disc (during large deflections of element 138). Referring to Figure 2, element 138 could deflect along spacer 142 but when it deflects, the outside edge of element 138 would contact in the area of 158 and not a position between the outside edge and a central axis of the first valve disc (138).

In reply to the Examiner's Response to Applicant's Argument in our Appeal Brief, please consider the following. The Examiner states that a chordal edge of second valve disc 144 in Yamaura is clearly taught. Applicant believes that the issue here is not a chordal edge since chordal edges are old in the art. The claims of the present invention define more than simply a chordal edge, the claims define that the chordal edge supports the first valve disc. The recess 19a of Furuya, et al. is not a chordal edge, it is a recess. Even though the shape, angle and the depth of outer edge 19a can be varied to vary the damping force, the only support the Examiner has to define this recess as a chordal edge is Applicants' disclosure.

The next argument that the Examiner makes is that Figure 3 of Furuya discloses a second valve disc 4d that is disposed adjacent to the first valve disc 4e. The Examiner indicates that arrow 4e clearly points to the first valve disc 4e. Applicant agrees that the arrow points to a first valve disc 4e which closes passage 403. The second valve disc 4d is not disposed adjacent this valve disc 4e. As is clearly illustrated in Figure 3, there is an additional valve disc disposed between the valve disc that closes passage 403 and washer 4d.

The Examiner then argues that in Figure 2 of Yamaura, et al. that second valve disc 144 is indeed disposed adjacent to first valve disc 138 via element 142. Element 142 in Yamaura, et al. is located between disc 144 and disc 138 and it thus spaces disc 144 from disc 138. The term adjacent is defined as "next to", "abutting" or "touching". Clearly, element 142 prevents disc 144 from being adjacent disc 138, it specifically spaces the two discs.

DOUBLE PATENTING

Applicants' 09/552,125 application issued on January 6, 2004 as U.S. Patent 6,672,436. The disclosure for this patent and the claims do not specifically define the pivot edge as being a chordal edge. Since it is Applicants' position that the chordal edge design is not obvious over the combination of Furuya, et al. in view of Tanaka and Yamaura, et al., it is also Applicants' position that the obviousness-type double patenting rejections are not valid rejections for the present application for the reasons set forth in Applicants' Appeal Brief and this Reply Brief.

Respectfully submitted,

Dated: January 12, 2003

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